

U.S. Patent No. 5,714,971 to Shalit et al. ("*Shalit*"), and U.S. Patent No. 6,262,732 to Coleman et al. ("*Coleman II*").

Applicant respectfully traverses the rejection of claims 1, 2, 4-9, and 11-15 under 35 U.S.C. § 103(a). The Examiner has failed to present a *prima facie* case of obviousness.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements."

M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. § 2143.01(III) (emphasis in original). "All words in a claim must be considered in judging the patentability of that claim against the prior art" (emphasis added). M.P.E.P. § 2143.03. "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I) (emphases in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s)

between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Claim 1 recites, in part, “*receive user input from a user to establish a decoupled mode when a key is pressed and held by the user, and to establish a normal mode when the key is released by the user; and receive navigation input, distinct from the user input, to navigate from one user interface element to another user interface element, where in the normal mode, navigation to an independent element with the navigation input is sufficient to cause the independent element to become the selected element, and where in the decoupled mode, navigation to an independent element does not change which, if any, of the independent elements is the selected element*” (emphasis added).

The Office Action acknowledges that *Coleman*, *Schirmer*, and *Schalit* fail to teach the claimed “decoupled mode.” However, the Office Action asserts that *Coleman II*’s disclosure of a drag and drop operation teaches the claimed decoupled mode, because “no other item can be selected to be manipulated therefore drag and drop is decoupled mode.” See Office Action, pgs. 4-5. The Office Action further asserts that it would have been obvious to combine *Coleman II* with the other applied references “in order to provide [a] user with a drag drop operation.” See Office Action, pg. 5. However, these assertions are incorrect.

First, *Coleman II*’s drag and drop operation cannot constitute the claimed “decoupled mode.” In *Coleman II*’s drag and drop operation, a cursor is moved to a desired object, the user presses and holds down a button or mouse to select the object,

and then the selected object is moved across the desktop by the user. Thus, in *Coleman II*'s drag and drop operation, the user cannot navigate to an independent element as the cursor is constantly attached to the selected object until the drag and drop operation is complete. Therefore, *Coleman II*'s drag and drop operation fails to teach or suggest the claimed decoupled mode wherein "navigation to an independent element does not change which, if any, of the independent elements is the selected element," as recited in claim 1.

Second, even if *Coleman II*'s drag and drop operation constituted the claimed decoupled mode, which Applicant does not concede, the Office Action's motivation to combine *Coleman II* and the other applied references is improper. As discussed above, rejections on obviousness cannot be sustained with mere conclusory statements. Simply asserting that one would be motivated to combine *Coleman II* with the other applied references "in order to provide [a] user with a drag drop operation" is a conclusory statement. Specifically, the Office Action fails to provide any reason why the other applied references would want and/or need a drag and drop operation. Indeed, many of the applied references already include a drag and drop operation. For example, *Shalit* discusses dragging a selected icon from a first pane to a second pane. See col. 2, lines 13-20. As another example, *Schirmer* discloses that a user with a mouse can click on a desired object "drag" it to the primary object display area. See col. 12, lines 13-17. Accordingly, as the applied references already include a drag and drop operation, one of ordinary skill in the art would not be motivated to combine these

references with *Coleman II* to provide users with an additional drag and drop operation, as alleged by the Examiner.

As outlined above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Furthermore, the Office Action has failed to provide a motivation to combine *Coleman II* with the other applied references. Accordingly, the Office Action has failed to clearly articulate a reason why the claim would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for independent claim 1, as well as for claims 2 and 4-7 depending therefrom

Although of different scope, independent claims 8 and 15 recite elements similar to those of claim 1 already discussed. Therefore, Applicant respectfully requests withdrawal of the rejection of independent claims 8 and 15 under 35 U.S.C. § 103(a), as well as dependent claims 9 and 11-14 at least for the reasons discussed with respect to claim 1.

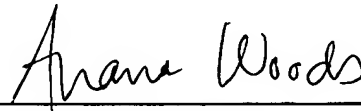
In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P

Dated: July 2, 2008

By: 
Ariana G. Woods
Reg. No. 58,977
(202) 408-4000